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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,811	02/04/2002	Thomas E. Ward III	IS/074 CONT 4.	6065
7590 Alexander Shvarts Fish & Neave 1251 Avenue of the Americas New York, NY 10020-1105	01/18/2007		EXAMINER PENG, FRED H	
			ART UNIT 2623	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	01/18/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/066,811	WARD ET AL.
	Examiner fred peng	Art Unit 2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09/22/06.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-58 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 February 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 02/04/02.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION*****Response to Arguments***

1. Applicant's arguments filed on 09/22/2006 have been fully considered but they are not persuasive.

Page 18 lines 8-13, applicant argues applicant's independent claims 1 and 57 patentably improve upon the teachings of Klosterman by "combining a portion of the received advertising information with a portion of the stored television schedule information to form a modified advertisement." Further, Page 18 Lines 23-25, accordingly, applicants submit that Klosterman fails to show or suggest every claimed feature of applicants' independent claims 1 and 57.

In response, examiner respectfully disagrees. Klosterman does show "combining a portion of the received advertising information with a portion of the stored television schedule information to form a modified advertisement" (Col 5 lines 57-64, new advertisement is received periodically and combine a portion of EPG to form a modified advertisement).

Page 20 lines 1-5, applicant argues applicant's claimed invention patentably improves upon the teachings of Schein. As described above, applicant's claimed invention forms a modified or updated advertisement by combining or incorporating stored program schedule information with advertisement information. Further, Page 20 Lines 12-14, accordingly, applicants submit that Schein fails to show or suggest every claimed feature of applicants' independent claims 20, 39 and 58.

In response, examiner respectfully disagrees. Schein does show forming a modified or updated advertisement by combining or incorporating stored program schedule information with advertisement information (Para 134 lines 1-9).

Based on the reasoning mentioned above, dependent claims 2-19, 21-38, and 40-56 are also rejected.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 20, 39, 42, 50, 51, 52, 53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 28, 13, 14, 15, 16, 17 of U.S. Patent No. 6,177,931 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because Patent's claim 28 teaches all the limitations in claim 20 about a method for modifying an advertisement in an EPG without teaching the first and the second database, but the memory taught in claim 28 would encompass both database in instant claim 20. Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to include the database as part of the memory. For claim 39, which is an EPG system claim corresponding to the patent's claim 13, which also teaches all the limitations in an EPG systems other than the memory vs. the database. The patent's claim 14 further teaches all the limitations for claims 42 and 50 except a service. However, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to include the service as part of the promotional information. The patent's claims 15,17 further anticipate all the limitations for claim 51 for input device for selecting and activating the selected advertisement.

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The patent's claims 15, 16 then further anticipate all the limitations for claims 52, 53 for the activated ad is linked to a web site based on an address for the ad and display more detailed information.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-19, 29-30, 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Klosterman et al. (US 5,940,073).

Regarding Claims 1 and 57, Klosterman discloses a method and a computer readable medium having stored thereon a set of instructions (Col. 5 lines 18-22) for displaying an advertisement in an EPG, when executed by a microprocessor, cause the microprocessor to perform the steps of:  
Storing TV schedule in a database (Col. 5 lines 2-6, Col 5 lines 18-22);  
Receiving advertisement information (Col. 4 lines 63-67, Col. 5 lines 1-2);  
Combining a portion of the advertisement with a portion of stored TV schedule information to form a modified advertisement (Col. 5 lines 48-66); and  
Displaying the modified information in the EPG on a screen (FIG.2(a)).

Regarding Claim 2, Klosterman further discloses method is performed in substantially real time (Col. 4 lines 63-67).

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Regarding Claims 3 and 13, Klosterman further discloses promotional information about a future TV program is a video preview (Col. 8 lines 26-35).

Regarding Claims 4 and 5, Klosterman further discloses promotional info about a currently telecast program and products and service (Col. 2 lines 2-4).

Regarding Claim 14, Klosterman further discloses promotional info about one or more of a product and a service is a video preview (Col. 8 lines 32-34).

Regarding Claim 6, Klosterman further discloses storing a program description and combining a portion of the received advertisement with stored program description (Col. 8 lines 34-36).

Regarding Claim 7, Klosterman further discloses storing a program telecast time and combining a portion of the received advertisement with stored program telecast time (Col. 8 lines 1-17).

Regarding Claim 8, Klosterman further discloses storing a web site address and combining a portion of the received advertisement with stored a web site address (Col. 9 lines 35-41).

Regarding Claim 9, Klosterman further discloses storing a info related to a geographical location and combining a portion of the received advertisement with the info related to a geographical location (Col. 12 lines 34-47).

Regarding Claim 10, Klosterman further discloses storing info related to a TV viewer and combining a portion of the received advertisement with the info related to a TV viewer (Col. 1 lines 29-45).

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Regarding Claims 11 and 12, Klosterman further discloses storing info related to rotating advertisement info in the EPG and combining a portion of the received advertisement with the info related to rotating advertisement info in the EPG and further display the advertisement info in the EPG based on the rotating advertisement info (Col. 5 lines 55-64, Col. 6 lines 2-4, FIG. 2(b)).

Regarding Claims 15, Klosterman further discloses steps of selecting the displayed info using a pointing device and activating a function related to the selected info (Col. 8. lines 32-35).

Regarding Claims 16, Klosterman further discloses step of activating a function comprising linking to a web site based on an address related to the selected info and displaying more info from the web sites (Col. 9 lines 19-32).

Regarding Claims 17, Klosterman further discloses step of activating a function comprising display more detail info related to the selected info (Col. 10 lines 31-34).

Regarding Claims 18, Klosterman further discloses step of activating a function comprising scheduling future TV program for recording (Col. 10 lines 41-43).

Regarding Claims 19, Klosterman further discloses step of activating a function comprising tuning to a currently telecast TV program (Col. 10 lines 34-36).

Regarding Claims 29 and 30, Klosterman further discloses storing schedule info step comprising storing info related to rotating advertisement info in the EPG and the incorporating steps comprising the incorporating a portion of the stored advertisement info with info related to rotating advertisement info and further display the advertisement info in the EPG based on the rotating advertisement info (Col.4 lines 63-65). Also see the rejections for claims 11 and 12.

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6. Claims 20-28, 31-56, 58 are also rejected under 35 U.S.C. 102(e) as being anticipated by Schein et al. (US 2003/0005445 A1).

Regarding Claims 20 and 58, Schein discloses a method and a computer readable medium having stored thereon a set of instructions (Para 33 lines 1-7) for modifying an advertisement in an EPG, when executed by a microprocessor, cause the microprocessor to perform the steps of:

Storing TV schedule in a first database (Para 47 lines 1-5);

Storing advertisement info in a 2nd database (Para 50 lines 1-4);

Incorporating a portion of the advertisement with a portion of stored TV schedule info to form a modified advertisement (Para 134 lines 1-9);

Displaying the modified *advertisement* on a screen (FIG.16A).

Regarding Claims 21 and 23, Schein further discloses storing advertisement info step comprising promotional info about a future TV program and one or more of a product and a service (Para 129 lines 1-7).

Regarding Claims 31 and 32, Schein further discloses Promotional info is a video preview (Para 133 lines 21-23).

Regarding Claims 22, Schein further discloses storing advertisement info step comprising promotional info about a currently telecast TV program (Paragraph 133 lines 21-25).

Regarding Claims 24, Schein further discloses storing schedule info step comprising storing a program description and the incorporating steps comprising the incorporating a portion of the stored advertisement info with the stored program description (Para 141 lines 3-9).

Regarding Claims 25, Schein further discloses storing schedule info step comprising storing a program telecast time and the incorporating steps comprising the incorporating a portion of the stored advertisement info with the stored program telecast time (Para 132 lines 1-5. Para 133 lines 21-22).

Regarding Claims 26, Schein further discloses storing schedule info step comprising storing a web site address and the incorporating steps comprising the incorporating a portion of the stored advertisement info with the stored web site address (Para 139 lines 1-11).

Regarding Claims 27, Schein further discloses storing schedule info step comprising storing a geographical location and the incorporating steps comprising the incorporating a portion of the stored advertisement info with the stored geographical location (Para 119 lines 1-11).

Regarding Claims 28, Schein further discloses storing schedule info step comprising storing info related to a TV viewer and the incorporating steps comprising the incorporating a portion of the stored advertisement info with the stored info related to a TV viewer (Para 122 lines 1-12, Para 123 lines 1-4).

Regarding Claims 33, Schein further discloses the steps of selecting the displayed advertisement using a pointing device and activating a function related to the selected advertisement (Para 131 lines 3-9).

Regarding Claims 34, Schein further discloses the steps of activating a function comprising linking to a web site based on the an address related to the selected advertisement and displaying more info from the web site (Para 144 lines 8-12).

Regarding Claims 35, Schein further discloses the steps of activating a function comprising more detail info related to the selected advertisement (Para 127 lines 1-6).

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Regarding Claims 36, Schein further discloses the steps of activating a function comprising displaying a video preview related to the selected advertisement (Para133 lines 21-26).

Regarding Claims 37, Schein further discloses the steps of activating a function comprising scheduling a future TV program for recording (Para 99 lines 1-6).

Regarding Claims 38, Schein further discloses the steps of activating a function comprising scheduling a future TV program for recording (Para137 lines 1-4).

Regarding Claims 39-47, 49-56, the system claims have been discussed with regards to the method claims of claims 20-28, 31-38.

Regarding Claim 48, Schein also discloses the 1<sup>st</sup> database includes info related to rotating ad info in the EPG for combining a portion of ad data with the stored info related to rotating ad info (Para 134 lines 4-9).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Peng whose telephone number is (571) 270-1147. The examiner can normally be reached on Monday-Friday 08:00-17:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fred Peng  
Patent Examiner

Chris Grant  
Supervisory Patent Examiner



SCOTT E. BELIVEAU  
PRIMARY PATENT EXAMINER